

REMARKS

In an Office Action mailed May 13, 2003, the Examiner stated that the application as originally filed, containing Claims 1-63, addressed two different inventions. Applicants traversed the Examiner's position in a Response filed June 9, 2003. The Examiner did not find the traversal persuasive, and in a second Office Action, mailed June 26, 2003, entered a second restriction requirement, asserting that Claims 1-31, drawn to a method for reducing corrosion of a head element during rework operations, is a distinct and different invention from Claims 43-50, drawn to a method of shipping a head element removed from a disk drive.

As a first matter, Applicants submit Claims 1-31 and 43-50 address reducing corrosion of a head element during rework operations with the head element removed from the disk drive. For at least this reason, and contrary to the Examiner's assertions, Claims 1-31 and 43-50 are best classified together under Class 29, Subclass 603.02. All of these claims involve disassembly of a disk drive and, therefore, are more properly classified in Subclass 603.02, rather than the making of a disk drive (Class 603.03). These claims are drawn to the same invention and should be examined as part of the same invention. The restriction requirement is improper and should be withdrawn.

In addition, Applicants resubmit Claims 32-42 and 51-63 in amended form. Like Claims 1-31 and 43-50, amended Claims 32-42 and 51-63 now address reducing corrosion of a head element during rework operations with the head element removed from the disk drive. Therefore, the Examiner's basis for maintaining restriction of Claims 32-42 and 51-63 is no longer present. More specifically, in paragraph 2 of the present Office Action, the Examiner asserts with respect to Claims 32-42 and 51-63 that "the product as claimed can be made by another and materially different process such as applying a protective coating to the head element prior to removal of the head

7/ element from the housing of the disk drive.” As amended, Claims 32-42 and 51-63 recite that the head element is removed from the disk drive. For at least these reasons, Claims 32-42 and 51-63 should remain in the present application and be examined with Claims 1-31 and 43-50 because each claim recites that the head element is removed from the disk drive.

With respect to paragraph 5 of the present Office Action, the Examiner’s proposed restriction requirement does not satisfy the threshold definition of Section 806.05(a) of the Manual of Patent Examining Procedures (MPEP). Under the definition of Section 806.05(a), an element does not qualify as a subcombination unless it is a necessary part of the combination. In other words, for the Examiner’s restriction to be correct, the Claims of Group I (1-31) must meet the definition of a combination and the claims of Group II (43-50) must meet the definition of a subcombination. For example, there cannot be elements in independent Claims 43 and 47 that are not in Claim 1. This is not the case. Claim 43 generally includes placing a head in a container and transporting the container. Claim 47 includes placing the head in a storage container. At least these elements are not found in Claim 1. Therefore, Claims 43 and 47 do not meet the definition of subcombination, e.g., they are not a necessary part of the combination. As a direct consequence, Claim 1 cannot meet the definition of combination. Therefore, the Examiner’s position that Claims 43-50 are a subcombination of the combination set forth in Claims 1-31 is incorrect. For at least this reason, the restriction requirement is improper and should be withdrawn.

Applicants further traverse the assertions made in paragraphs 7 and 8 of the Office Action. In particular, the Examiner asserts that Groups I and II contain claims directed to patentably distinct species and further identifies which claims are drawn to which species. However, pursuant to Section 806.04(e), MPEP, claims are never and cannot be species. Rather, species are the

specifically different embodiments. Despite this requirement, the Examiner has defined whole claims as being species. Due to the Examiner's approach, Applicants are in a position where they cannot respond, and therefore cannot make even a provisional election. There is simply insufficient information on which to make a determination and election. Clarification is requested.

If Applicants must make an election, they elect the invention defined by Class 29, Subclass 603.03. Applicants believe this encompasses Claims 1-42 and 51-63. Subject to the foregoing Remarks, if the Examiner is unpersuaded by Applicants' position, Applicants provisionally elect Group I (Claims 1-31).

In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Todd P. Blakely
Registration No. 31,328
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

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